



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,419	04/11/2001	Gregory E. Gonye	BC1042 US NA	9546

23906 7590 07/03/2002

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1128
4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER

MCKELVEY, TERRY ALAN

ART UNIT	PAPER NUMBER
----------	--------------

1636

DATE MAILED: 07/03/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,419

Applicant(s)

GONYE ET AL.

Examiner

Terry Mckelvey

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2 and 9-13 (only in so far as claims 9-13 depend on claims 1-2), drawn to method for determining gene function between at least two genome-registered collections, classified in class 435, subclass 29.
- II. Claims 3-4 and 9-13 (only in so far as claims 9-13 depend on claims 3-4), drawn to method for generating a genome-registered collection of reporter gene fusions, classified in class 435, subclass 455.
- III. Claims 5-6 and 9-13 (only in so far as claims 9-13 depend on claims 5-6), drawn to method for generating a genome-registered collection of reporter gene fusions, classified in class 435, subclass 455.
- IV. Claims 7 and 9-13 (only in so far as claims 9-13 depend on claim 7), drawn to method for generating a genome-registered collection of reporter gene fusions, classified in class 435, subclass 455.
- V. Claims 8 and 9-13 (only in so far as claims 9-13 depend on claim 8), drawn to method for generating a

Art Unit: 1636

genome-registered collection of reporter gene fusions,
classified in class 435, subclass 455.

VI. Claims 14-15, drawn to method for identifying a
profile of inducing conditions, classified in class
435, subclass 375.

VII. Claims 16, drawn to method for identifying a profile
of inducing conditions, classified in class 435,
subclass 375.

VIII. Claim 17, drawn to method to validate results from
genome analysis, classified in class 435, subclass 6.

IX. Claim 18, drawn to method to determine operon
structure, classified in class 435, subclass 6.

X. Claim 19, drawn to method for constructing a cellular
array, classified in class 435, subclass 91.4.

XI. Claims 20-22, drawn to method for measuring gene
expression responses, classified in class 435,
subclass 6.

The inventions are distinct, each from the other because of
the following reasons:

Inventions of Groups I-XI are biologically and functionally
different and distinct from each other and thus one does not
render the other obvious. The methods of Groups I-XI comprise
steps which are not required for or present in the methods of

Art Unit: 1636

the other groups: analyzing the results of at least one perturbation to identify patterns of similarities (Group I), registering the reporter gene fusions on the basis of sequence homology (Group II), determining the nucleic acid sequences of the distal and proximal ends of random nucleic acid fragments (Group III), amplifying portions of the genome with primers (Group IV), introducing transposons into the genome (Group V), obtaining a gene expression profile of an organism under induced and non-induced conditions (Group VI), obtaining a gene expression profile for each mutant strain and parental strain under induced and non-induced conditions (Group VII), testing expression of the reporter gene fusions with the conditions or chemicals used and comparing the gene expression results (Group VIII), determining operon structure (Group IX), fixing the non-redundant subset of reporter gene fusions in an array format (Group X), and comparing the differences between the gene expression activity of a control and the experimental array (Group XI). The end result of the methods are different because they depend on different method steps. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by

Art Unit: 1636

their different classification, and the searches required for each of the groups of the same/subclass are different from each other with regard to the non-patent literature search because each method step not in common must be searched for in separate, non-overlapping searches, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: use of different types of perturbation, such as those set forth in claim 2.

Applicant is also required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 20 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

Art Unit: 1636

named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014.

NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning missing attachments or other minor formalities of this communication should be directed to the patent analyst, Zeta Adams, whose telephone number is (703) 305-3291.

Any inquiry concerning rejections or other major issues in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (703) 305-7213. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to

Art Unit: 1636

about 6:00 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to his office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, can be reached at (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Terry A. McKelvey, Ph.D.
Primary Examiner
Art Unit 1636

July 1, 2002